

## REMARKS

In the office action mailed from the United States Patent and Trademark Office April 13, 2006, the Examiner rejected claims 1, 3, 5 and 7. Applicant respectfully traverses the rejections and provides the following:

### Rejections Under 35 U.S.C. § 103

The Examiner indicated that claims 1, 3, 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the publication from www.nonialoha.com (May 2003) in view of HU 43310, (“HU”), U.S. Patent No. 4,459,149, to Moran et al. (“Moran”), U.S. Patent No. 5,648,264, to Kume (“Kume”) and Dougherty, Field Guide to On-Farm Composting, pages 1-3, 26-29 (March 1999) (“Dougherty”), and further in view of U.S. Patent No. 3,821,963, to Olson et al. (“Olson”) and U.S. Patent No. 3,770,198, to Mihara (“Mihara”).

As indicated by the Examiner in the pending office action, none of the references cited specifically teach a fertilizer comprising Yaeyama Aoki juice, further none of the references cited by the Examiner suggest combining the leaves and seeds of the plant with juice to be utilized as a fertilizer. The series of secondary references do not suggest combining compost with juice and none of the references suggest composting specifically Yaeyama Aoki leaves and seeds with the juice of the fruit.

HU teaches a method for rendering organic waste safe by combination with agricultural products. HU does not teach a method of combining the Yaeyama Aoki juice leaves and seeds to produce a fertilizer. Moran teaches the isolation of Humic Acid from compost materials. Moran does not teach the combination of the Yaeyama Aoki juice leaves and seeds. Kume teaches away from utilizing the juice, an expensive non-efficient

product, as an organic fertilizer. Rather, Kume teaches a method for utilizing cheap and efficiently decomposed materials as a cost efficient fertilizer. Accordingly, Kume fails to teach a combination of Yaeyama Aoki juice leaves and seeds in a fertilizer. Likewise, the additional references fail to teach utilizing an expensive product, the juice of Yaeyama Aoki as a fertilizer in combination with other materials from the Yaeyama Aoki plant, namely leaves and seeds.

The non-obvious combination of utilizing juice, an expensive material, with processed leaves and seeds from the Yaeyama Aoki plant yielded unexpected results that are not taught or suggested in the art cited by the Examiner. As indicated in the specification of the presently filed application, not only was growth of strawberries increased, but the sugar content of the strawberries was increased, white flower disease was prevented from spreading, and the fruits' freshness after harvest was increased all results not previously taught or suggested in the art. Accordingly, the non-obvious application of Yaeyama Aoki juice in combination with the leaves and seeds from the plant produced non-obvious results, which were not taught or suggested in the art. Accordingly, Applicant respectfully submits that the claims as presently amended contain non-obvious limitations and are allowable over the cited art.

#### There Is No Suggestion to Combine

The prior art does not suggest the combination of references cited against the present invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re*

*Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); MPEP § 2142. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142. Thus, to establish a prima facie case of obviousness against the present invention the Examiner must identify a suggestion in the prior art.

For the reasons set forth below, Applicant submits that the prior art fails to clearly and particularly suggest the combination indicated by the Examiner. Thus, Applicant’s claims are not obvious in view of the prior art references. In essence the Applicant urges that the combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. “Hindsight reconstruction” cannot be used “to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

*Ecolochem, Inc. v. S. California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Rather, “the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *Id.* “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat

patentability-the essence of hindsight." *Id.* (quoting *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999))

In light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could be combined in the manner suggested by the Examiner does not render the present invention obvious. MPEP § 2142. Moreover, in this case the combined references fail to produce or suggest each element of the claimed invention.


### CONCLUSION

Based on the foregoing, Applicant respectfully submits that the deficiencies in the application have been corrected and that the proposed claims are neither anticipated nor rendered obvious by the prior art references cited by the Examiner. As such, Applicant believes that the claims are now in a condition for allowance, and action to that end is respectfully requested.

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 30 day of June, 2006.

Respectfully submitted,



Michael H. Krieger  
Attorney for Applicant  
Registration No. 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple Street  
Salt Lake City, Utah 84111  
(801) 328-3600 telephone  
(801) 321-4893 facsimile

JRM/krw  
DOC# 905177